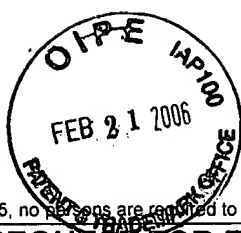


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PTO/SB/SS (07-05)

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Signature

Typed or printed

name Lawrence H. AaronsonApplication Number
09/976,801Filed
October 12, 2001First Named Inventor
Michael T. LundyArt Unit
3627Examiner
Andrew J. Rudy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 35,818

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Lawrence H. Aaronson

Typed or printed name

312 913-2141

Telephone number

February 17, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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to be sent to the subscriber terminal. Given the authorization, the advertisement is then sent to the subscriber terminal when a triggering event occurs.

Claims 6 and 12 similarly include the authorization request and/or reply and also recite displaying the advertisement on the subscriber terminal when at least one triggering event occurs. And claim 10 similarly includes the authorization request and reply and sending the advertisement to the subscriber terminal when at least one triggering event occurs.

Dependent claims 2, 7, and 11 further define the triggering event as either the subscriber terminal being idle or the subscriber terminal being substantially stationary. And dependent claims 5 and 9 further limit the method by defining the triggering event as the subscriber terminal being *both* idle *and* substantially stationary.

2. Clear Error by the Examiner

In the final office action, the Examiner rejected all of the claims as being allegedly obvious over U.S. Patent No. 6,892,354 (Servan-Schreiber) in view of the fact that "triggering events are common knowledge in the telecommunication art, as are stationary subscriber terminals." This rejection is clearly erroneous, because Servan-Schreiber fails to disclose or suggest anything about receiving or replying to an advertising authorization request as recited in Applicant's claims, and because the general concepts of "triggering events" and "stationary subscriber terminals" do not make up for that basic deficiency of Servan-Schreiber.

Servan-Schreiber is directed to a method of downloading advertisements to a computer when the computer is idle. In particular, Servan-Schreiber teaches that, after content has been downloaded to a computer, the computer will then background-download an advertisement, which the computer can then display to a user when waiting for a next content download to complete.

The fact that Servan-Schreiber discloses a computer downloading an advertisement does not amount to, or suggest, Applicant's claimed invention. At a minimum, it does not suggest providing an *advertising authorization request* or receiving (or retrieving) a *reply to an advertising authorization request* as recited in Applicant's claims. The closest it comes to this is teaching that the computer downloads an advertisement, typically by sending a request (perhaps an HTTP request) to a remote server and receiving the advertisement in response. (See, e.g., column 3, lines 6-15). However, the act of a subscriber terminal requesting an advertisement and receiving the advertisement in response does not constitute the advertising authorization request functionality recited in Applicant's claims.

In this regard, claims 1 and 6 make clear that the advertising authorization request and reply occur *before* sending an advertisement to a subscriber terminal, as the claims recite that the advertisement is sent in response to the authorization (or in response to the reply). Further claims 1 and 6 recite that *the advertising authorization request is sent to the subscriber terminal* and that the *reply to that request is received from the subscriber terminal*. In Servan-Schreiber, the only advertising-related request that precedes sending of the advertisement to the subscriber terminal is a request *from the computer to the server*, seeking the advertisement. However, this request cannot be the "advertising authorization request" of Applicant's claims, because it is not a request *to the subscriber terminal* (and because it is not seeking authorization of any kind). Further, the resulting transmission of an advertisement from the server to the subscriber terminal cannot then be the "reply" of Applicant's claims, because the transmission of the advertisement is not a transmission *from the subscriber terminal* (and because it is not a reply to an authorization request of any kind). Thus, Servan-Schreiber fails to suggest the invention of claims 1 and 6.

Claims 10 and 12 recite the function of retrieving a reply to an advertising authorization request, where the reply authorizes at least one advertisement to be sent to a subscriber terminal. In Servan-Schreiber, there is no teaching of an advertising authorization request, and thus there is no teaching of a reply to such a request. Servan-Schreiber's teaching of sending a request for an advertisement from a computer to a server cannot be the "advertising authorization request" of Applicant's claims, because it is not a request seeking authorization of any kind. Further, Servan-Schreiber's teaching of responsively sending an advertisement from the server to the subscriber terminal cannot be the "reply" of Applicant's claims, because it is not a reply to an authorization request of any kind and particularly because it is not a reply that authorizes at least one advertisement to be sent to the subscriber terminal. Thus, Servan-Schreiber fails to suggest the invention of claims 10 and 12.

In rejecting the claims, the Examiner noted that Servan-Schreiber does not disclose the triggering event but asserted that triggering events are generally well known. (Similarly, the Examiner focused on just this point in the advisory action mailed February 2, 2006.) With all due respect, the Examiner's focus on the triggering events seems to disregard the more basic failure of Servan-Schreiber to teach anything about an advertising authorization request. Further, the Examiner has not pointed to any objective evidence that would suggest modifying Servan-Schreiber in order to achieve the claimed advertising authorization request functionality or to include the triggering event functionality in that context. Thus, the Examiner has not made out the requisite *prima facie* case of obviousness of Applicant's claims.

3. Conclusion

Because the Examiner has not pointed to any objective evidence in the art that suggests the presently claimed invention, the Examiner has clearly erred in rejecting the claims under 35

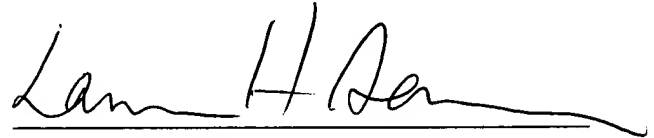
U.S.C. § 103. Therefore, Applicant submits that the rejections should be withdrawn and all of the claims should be allowed.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: February 17, 2006

By:

A handwritten signature in black ink, appearing to read "Law H Aaronson", written over a horizontal line.

Lawrence H. Aaronson
Reg. No. 35,818